

### Remarks

This amendment responds to the Office Action dated March 28, 2003 (Paper No. 6).

In the Office Action, the examiner rejected all the claims 1 - 8 as being non-patentable in view of certain prior or pre-existing technology or art disclosed in the following references:

British Patent Publication No. 17,666 to Fleming (Flemming '666)

U.S. Design Patent No.424,303 to Tobias (Tobia '303)

U.S. Patent No.3,691,585 to Flom (Flom '585)

U.S. Design Patent No.118,422 to Weber (Weber '422)

U.S. Design Patent No. 292,850 to Glasberg (Glasberg '850)

Claim 1 has been amended to specifically recite that the Applicant claims a hair brush "for a person's scalp" and "a plurality of head hair bristles of various lengths long enough to brush head hair on said person's scalp, said bristles attached over said bristle substrate." Support for this concept is found in the drawings and in the patent specification as follows.

The specification provides that the presently claimed invention provides "an anatomically correct hair brush." Specification paragraph 4 (herein "pp 4"). The recited invention "requires less force to pass through the user's hair." pp. 8. The hair brush "presents less bristle material in the central mid-region of the brush thereby reducing the force needed to brush one's hair and enhancing the heating and blow drying of one's hair." pp. 9. The brush "enables the user to roll-up more hair on the brush due to hourglass shape of the bristle substrate." pp. 11. It is another advantage of the present invention to provide a brush with an "hourglass shape [which] enables a tighter hold on the hair wrapped about the hourglass shaped bristle system." pp. 12. Further the brush provides "an anatomically correct hair brush which, when utilized, creates hair

styles with more volume.” pp. 13. Support for new claim 9 is also found in the specification and in the drawings. No new matter is added to the specification by these changes to the claims.

Claim 1 specifically recites that it relates to “A hair brush for a person’s head or scalp” and recites that the hair brush includes “a plurality of head hair bristles of various lengths long enough to brush head hair on said person’s scalp, said bristles attached over said bristle substrate.” These are not statements of intended use but represent structural limitations defining the scope and breadth of the patent claim. Likewise, new claim 9 recites “A head hair brush for a person’s head or scalp” and positively recites “said bristle substrate carrying a plurality of head hair brush bristles.” These are not statements of intended use but represent structural limitations in the claim, to wit, “head hair brush bristles.”

Since Flemming ‘666, Flom ‘585 and Tobias ‘303 all relate to tooth brushes and the claimed invention relates to head hair brushes, those references cannot anticipate the present invention. Applicant respectfully requests that the examiner withdraw the section 102 rejection applied against claim 1 and approve that claim.

Flemming ‘666, Flom ‘585 and Tobias ‘303 all relate to tooth brushes and since the claimed invention relates to head hair brushes, toothbrush technology is nonanalogous art compared with head hair brush technology.

The art relevant to a consideration of obviousness is the analogous art. *Wang Lab., Inc. v. Toshiba Corp.*, 993 F.2d 858, 864 (Fed. Cir. 1993). **Non-analogous art** is too remote to constitute prior art. *In re Clay*, 966 F.2d 656, 658 (Fed. Cir. 1992). Two criteria determine whether a particular reference is analogous art. First, if the reference is within the inventor’s field of endeavor, then it is deemed analogous. *Wang*, 993 F.2d at 864; *Clay*, 966 F.2d at 659; *Bausch & Lomb, Inc., v. Barnes-Hind/Hydrocurve, Inc.*, 796 F.2d 443, 449 (Fed. Cir. 1986) cert. denied 484 U.S. 823 (1987). Second, if the reference is reasonably pertinent to the particular problem with which the inventor was involved, it is prior art. *Wang*, 993 F.2d at 864; *Clay*,

966 F.2d at 659; *Baush & Lomb, Inc.*, 796 F.2d at 449.  
*Penda Corp v. U.S.*, 29 Fed. Cl. 533, 557-58, 1993 U.S. Claims Lexis 161 (Ct. Fed. Cl. 1993).

The § 103 analysis requires a determination regarding (i) the scope and content of prior art, (ii) the differences between the prior art and the claimed invention and (iii) a determination regarding whether a person of ordinary skill in the art would think the differences obvious (and hence not patentable) or non-obvious ( and patentable). 35 U.S.C. §103.

The relevant inquiry for determining the scope and content of the prior art is whether there is a reason, suggestion, or motivation in the prior art or elsewhere that would have led one of ordinary skill in the art to combine the references. *Ruiz et al. v. A.B. Chance Co.*, 234 F.3d 654, 664 (Fed. Cir. 2000)

The reason, suggestion, or motivation to combine may be found explicitly or implicitly: (1) in the prior art references themselves; (2) in the knowledge of those of ordinary skill in the art that certain references, or disclosures in those references, are of special interest or importance in the field; or (3) from the nature of the problem to be solved, "leading inventors to look to references relating to possible solutions to that problem."

*Id.* at 665 (quoting *Pro-Mold & Tool Co. v. Great Lake Plastics, Inc.*, 75 F.3d 1568, 1572 (Fed. Cir. 1996)).

Simply put, toothbrushes are non-analogous prior art to head hair brushes. The person of ordinary skill in the art would not look to toothbrush technology to solve the problems associated with hair brushes for one's head.

Toothbrushes in general, and the toothbrush in Flemming '666 in particular, simply do not have the attributes and advantages of the present invention. Toothbrushes, including Flemming '666's toothbrush, operate on hard surfaces. The teeth and the surfaces of the teeth do not move when brushed. The surface area of the teeth to be brushed is much smaller compared to the surface area of a person's scalp. Teeth have a much smaller curvaceous surface area in comparison to the

curvaceous surface area of a person's head. Teeth carry no hair-like projections like a person's head.

A person's hair typically ranges from 1 to 2 centimeters for short hair to 20 to 30 centimeters for longer hair. This is common knowledge that a person of ordinary skill in the art would know and appreciate. Because there are no hair-like growths on teeth, there is no appreciation of the following stated advantages of the present invention: (a) the hairbrush "requires less force to pass through the user's hair" (p. 1); (b) the hairbrush provides "less bristle material in the central mid-region of the brush thereby reducing the force needed to brush one's hair and enhancing the heating and blow drying of one's hair" (p. 1); (c) the hairbrush "enables the user to roll-up more hair on the brush due to hourglass shape of the bristle substrate" (p. 2); (d) "the hourglass shape enables a tighter hold on the hair wrapped about the hourglass shaped bristle system" (p. 2); and, (e) the hairbrush "creates hair styles with more volume" (p. 2). The problems solved by the presently claimed invention are completely absent from the toothbrush technology. A person of ordinary skill in the art would not find a reason, suggestion or motivation to look to toothbrush technology to solve the stated problems in the head hair brush technology.

The function of a toothbrush is entirely different than the function of a hair brush. A head hair brush is configured to move and alter long strands of head hair extending from the person's scalp. A toothbrush has short bristles adapted to scrape or brush away material on a substantially smooth surface, that "smooth surface" referring to a surface that does not have long strands of highly flexible material protruding therefrom. A head hair brush is specifically designed to alter and manipulate the head hair strands. Toothbrushes do not manipulate strands of material.

The purpose of the toothbrush is to clean teeth, not arrange hair like growths on the teeth for grooming. Conversely, a head hair brush is not used to scrape plaque and other temporarily affixed compositions from the surface of teeth. Because there is no hair-like projections growing from teeth, there is no need to have faster hair drying times. The toothbrush substrate is significantly shorter than the hairbrush substrate. Similarly, the toothbrush bristles are significantly shorter than the hairbrush bristles. Finally, no reasonable person would consider brushing his or her hair with a toothbrush or brushing his or her teeth with a hairbrush.

It is respectfully submitted that the presently claimed hair brush for brushing "head hair" (1) is not structurally equivalent to a toothbrush, (2) does not possess all the structural elements of the toothbrushes shown in the references identified by the examiner, and (3) does not have a similar utility. The presently claimed invention specifically recites "a plurality of head hair brush bristles ... long enough to brush head hair" or "head hair bristles." None of the toothbrush references identified by the examiner show, teach or suggest head hair brush bristles. The utility of a head hair brush is much different than the utility of a toothbrush as explained above.

The term "head hair" is used in many other patents and, as such, the term defines structure, not intended use. See abstract in U.S. Patent Nos. 6,423,854; 6,636,135; 6,326,014; 6,306,376; 6,267,119; 6,228,350; 6,159,482; 5,694,750; 5,389,649; 5,082,010; 4,958,647; and 4,672,983.

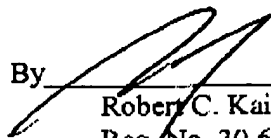
With respect to the brush references cited by the Examiner, Weber '422, Riche or U.S. '648 and Glasberg '850, none of those references bridge the gap between toothbrushes and head hair brushes and none of those references show the hourglass or concave shaped head hair brush claimed herein.

It is respectfully requested that the examiner withdraw the rejection applied against claims 2 - 5 (claims 6 - 8 cancelled without prejudice to reinstate the same at a later time, i.e., without disclaimer) and approve those claims and new claim 9 as being patentable.

Respectfully submitted,

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**FACSIMILE COVER SHEET**

In re Application of Alberto Lee Bigio  
Serial No. 09/731,191  
Filed: December 6, 2000  
For: HAIR BRUSH

Calling: 703-872-9310

Number of pages including cover sheet: 11

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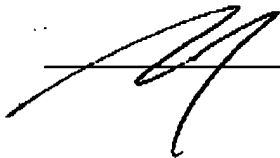
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**CERTIFICATION OF FACSIMILE TRANSMISSION**

I HEREBY CERTIFY THAT THE FOLLOWING AMENDMENT *(pp. 10)* IN THE ABOVE CAPTIONED CASE IS BEING FACSIMILE TRANSMITTED TO THE PATENT AND TRADEMARK OFFICE, EXAMINER MARK SPISICH, FAX NUMBER 703-872-9310 ON THE DATE SHOWN BELOW.

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Date: June 2, 2003